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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/557,611	11/22/2005	Atsutoshi Ikesue	7388/8-4495	1480
20/529	7/5/0	04/17/2008		
NATH & ASSOCIATES 112 South West Street Alexandria, VA 22314			EXAMINER WINTERBERG, NISSA M	
			ART UNIT	PAPER NUMBER
			1618	
			MAIL DATE	DELIVERY MODE
			04/17/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/557,611

**Applicant(s)**

IKESUE ET AL.

**Examiner**

Nissa M. Westerberg

**Art Unit**

1618

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 13 is/are pending in the application.
- 4a) Of the above claim(s) 5 - 7, 12, 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 3 is/are rejected.
- 7) ☒ Claim(s) 4, 8 - 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
- Paper No(s)/Mail Date 12/8/05
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of group I and components of propyl gallate, di-*tert*-butylhydroxytoluene (BHT, paragraph [0020]) and ketoprofen in the reply filed on February 7, 2008 is acknowledged. The traversal is on the ground(s) that no appropriate explanation as to the existence of a serious search burden was given. This is not found persuasive because this application was filed as a National Stage Entry of a PCT application. As such, restriction and species elections are based on the special technical feature of the application and not on the showing of a search and examination burden. The feature in common between the groups was shown to be known in the art, and since a special technical feature must be a contribution over the prior art, a special technical feature does not link the various groups presented. Therefore the restriction and species election was proper.

While applicant is correct in asserting that claims 1 – 4 require the presence of both an alkyl ester of gallic acid and a phenolic radical scavenger, claims 8 – 11 only require the presence of one of these two ingredients. Therefore, the description of group I given in the Requirement for Restriction/Election was of the broadest embodiment within the group, which does not require the presence of both an alkyl ester of gallic acid and a phenolic radical scavenger.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Objections***

2. Claims 4 and 8 – 11 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 – 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertrand et al. (FR 2804024; English language Derwent abstract) in view of Swingle et al. (1985).

Bertrand et al. discloses compositions for topical application to the skin (an transdermal formulation for external application) that comprise at least one non-steroidal anti-inflammatory active agent, at least one UV radiation filter and a carrier (novelty paragraph, p 3). The composition is intended to locally treat inflammation and/or joint pain (p 3). Preferred NSAIDS include ketoprofen (p 4). Optional ingredients include antioxidants such as BHA and BHT (t-butyl p-cresol; p 3). An example comprising ketoprofen and BHA is presented (p 4 – 7).

Bertrand et al. does not exemplify a composition comprising BHT or disclose propyl gallate as a possible ingredient in the topical composition comprising ketoprofen.

Swingle et al. discloses that both BHT and propyl gallate are phenolic antioxidants that exhibit *in vivo* anti-inflammatory activity (p 113, section IV and table 1, p 114). The efficacy of these compounds as anti-inflammatory agents in different models of inflammation is presented in table 1 (p 114).

Swingle et al. teaches that BHT and propyl gallate possess antioxidants but also act as non-steroidal anti-inflammatory agents. As such, these compounds would be useful for the treatment of inflammation. Bertrand et al. discloses a composition comprising ketoprofen and an antioxidant such as BHA or BHT that is also useful for the treatment of inflammation. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to prepare a composition comprising ketoprofen, BHT and propyl gallate as the prior art teaches each component as being useful for the same purpose. "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) **MPEP 2144.06**.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nissa M. Westerberg whose telephone number is (571)270-3532. The examiner can normally be reached on M - F, 8 a.m. - 4 p.m. ET. If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

NMW